UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/941,515	08/28/2001	Eliyahu Marmor	018/02357	7272

26418 7590 05/18/2004

REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

EXAMINER	
NAJJAR, SALEH	

ART UNIT	PAPER NUMBER
2157	

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/941,515	MARMOR, ELIYAHU	
	Examiner	Art Unit	
	Saleh Najjar	2157	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-46* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. This action is responsive to the request for continued examination filed on April 26, 2004. Claim 24 was amended. Claims 28-46 are newly added. Claims 1-46 pending.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-3, 5-12, 17-20, and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Rabne et al., U.S. Patent No. 6,006,332.

Rabne teaches the invention as claimed including a rights management system for digital media (see abstract).

As to claim 1, Rabne teaches a method for controlling the viewing of copyrighted information, transmitted from a data source to a client, on the Internet, comprising:

transmitting the information from the data source to a server, wherein said information is in a format suitable for viewing by the client (see fig. 1b; col. 10);

converting the information, at the server, to an encoded form (see figs. 1-2; col. 7, Rabne discloses that RM server is responsible for authenticating the request and encrypting the result of the request for download to the client);

transmitting the encoded form of the information to the client (see col. 7, Rabne discloses that the encrypted information is transmitted to the client); and

displaying the encoded information at the client, wherein said encoding makes said information less available to copying by said client when displayed (see figs. 1-15; col. 14-20, Rabne discloses that the information displayed at the client is less susceptible to copying/clipping).

As to claim 2, Rabne teaches the method of claim 1 above, wherein said format of said information is a format used on the Internet (see col. 14-20).

As to claim 3, Rabne teaches the method of claim 1 above wherein the information is in HTML format (see col. 7-14).

As to claim 5, Rabne teaches the method of claim 2 wherein said decoding is performed by a server provided program (see co. 7-20, Rabne discloses that a special browser program is downloaded to the client for displaying the information requested)

As to claim 6, Rabne teaches the method of claim 5, wherein said program requires a live connection with said server (see col. 7-20).

As to claim 7, Rabne teaches the method according to claim 5, wherein said program is downloaded from the server (see col. 7-20).

As to claim 8, Rabne teaches the method of claim 5 above comprising authenticating the server-provided program to the server (see col. 11-14).

As to claim 9, Rabne teaches the method of claim 5 above, wherein said converting comprises converting said information to a form unusable by said client without said server-provided program (see col. 10-14, Rabne discloses that the information is encrypted such that no other than the rights management browser can decrypt the information).

As to claim 10, Rabne teaches the method of claim 1 above wherein said converting comprises encrypting (see col. 10-14).

As to claim 11, Rabne teaches the method of claim 1 above, wherein said converting the information comprises converting only a portion of the information (see col. 10-14).

As to claim 12, Rabne teaches the method of claims 1-3, comprising at least partially decoding the information before displaying it (see col. 10-14).

As to claims 17-19, Rabne teaches the method of claim 1, wherein said transmitting is in response to said client request, and wherein said server performs encoding on demand by the data source, and wherein said information is compiled from multiple sources at the data source (see figs. 1-15; col. 10-20).

As to claim 20, Rabne teaches the method of claim 1, wherein said encoding converts at least one text object to at least one non-text object (see col. 20, Rabne discloses that text objects in a browser window transmitted from the source server may be grayed out).

As to claim 22, Rabne teaches the method of claim 19, wherein said source is a web server (see col. 10-20).

As to claim 23, Rabne teaches the method of claim 1, wherein said encoding reduces the ability of intercepting said information (see col. 9-14).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabne further in view of Chaddha et al, U.S. Patent No. 5,621,660.

Rabne teaches the invention substantially as claimed including a rights management system for digital media (see abstract).

As to claim 4, Rabne teaches method of claims 1-3 above wherein said displaying comprises hindering copying of the information (see col. 17-20, Rabne discloses that the ability to clip/ or download information is hindered by the downloaded browser).

Rabne does fails to teach the limitation of temporally modulating the display of the information.

However, Chaddha teaches a software-based encoder for software implemented end to end scalable video delivery system (see abstract). Chaddha teaches temporally modulating a high resolution data object to lower resolution object (see col. 4-12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rabne by including the temporal modulation as taught by Chaddha to prevent copyrights infringements.

6. Claims 13-16, 24-29, 31-34, and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rabne further in view of Tso et al., U.S. Patent No. 6,185,625.

Rabne teaches the invention substantially as claimed including a rights management system for digital media (see abstract).

As to claims 13-14, Rabne teaches the method of claim 12 above.

Rabne fails to teach the limitation wherein at least one of said encoding and decoding comprises modifying some of the information so that the displayed information differs from the original in format.

However, Tso teaches a scaling proxy server that modifies requested objects requested by the clients in accordance with the user's preferences (see abstract). Tso discloses that encoding and decoding comprises modifying some of the information so that the displayed information differs from the original in format (see col. 14, Tso discloses that the information requested may be sent in a format different from that of the original).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rabne so that information is encoded and decoded so that it is displayed in a format different from that of the original. One would be motivated to do so to prevent the client from downloading an alternative decoder.

As to claim 15, Rabne teaches the method of claim 1 above.

Rabne fails to teach the limitation wherein said server acts as a proxy server to transparently encode and transmit the requested information.

However, Tso teaches a scaling proxy server that modifies requested objects requested by the clients in accordance with the user's preferences (see abstract). Tso discloses that a proxy transparently encodes the requested data (see figs. 2-7; col. 4-6, Tso discloses that a scaling proxy is used to encode information requested by the client).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rabne so that a proxy is used to transparently encode information

requested by the client as in Tso. One would be motivated to do so to protect a LAN from unauthorized access over the Internet.

As to claim 16, Rabne teaches the method of claim 15 above, wherein said server does not require substantial changes in said client (see col. 6-14).

Claims 24-27, 28-29, 31-34, 37-46 do not teach or define any new limitations above claims1-3, 5-12, 13-20, 22-23 and therefore are rejected for similar reasons.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabne further in view of Gerace, U.S. Patent No. 5,991,735.

Rabne teaches the invention substantially as claimed including a rights management system for digital media (see abstract).

As to claim 21, Rabne teaches the method of claim 1 above.

Rabne fails to teach the limitation wherein said encoding converts at least part of a static object to a dynamic object.

However, Gerace teaches a system and method for customized web page display to users based on user's behavior (see abstract). Gerace teaches wherein said encoding converts at least part of a static object to a dynamic object (see col. 14-15, Gerace teaches that a static entry in a client's portfolio is encode such that a flickering screen ticker appears to the client viewing the stocks web page).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rabne in view of Gerace to affect conversion of static content to dynamic content. One would be motivated to do so to target users having an interest in a particular information.

8. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabne in view of Tso, further in view of Chaddha et al, U.S. Patent No. 5,621,660.
Rabne teaches the invention substantially as claimed including a rights management system for digital media (see abstract).

As to claim 30 , Rabne teaches method of claim 29 above wherein said displaying comprises hindering copying of the information (see col. 17-20, Rabne

discloses that the ability to clip/ or download information is hindered by the downloaded browser).

Rabne does fails to teach the limitation of temporally modulating the display of the information.

However, Chaddha teaches a software-based encoder for software implemented end to end scalable video delivery system (see abstract). Chaddha teaches temporally modulating a high resolution data object to lower resolution object (see col. 4-12).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rabne by including the temporal modulation as taught by Chaddha to prevent copyrights infringements.

9. Claims 35-36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rabne further in view of Gerace, U.S. Patent No. 5,991,735.

Rabne teaches the invention substantially as claimed including a rights management system for digital media (see abstract).

As to claims 35-36, Rabne teaches the method of claim 1 above.

Rabne fails to teach the limitation wherein said encoding converts at least part of a static object to a dynamic object or an advertisement.

However, Gerace teaches a system and method for customized web page display to users based on user's behavior (see abstract). Gerace teaches wherein said encoding converts at least part of a static object to a dynamic object or an advertisement (see col. 14-15, Gerace teaches that a static entry in a client's portfolio is encode such that a flickering screen ticker appears to the client viewing the stocks web page).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Rabne in view of Gerace to affect conversion of static content to dynamic content. One would be motivated to do so to target users having an interest in a particular information.

10. Applicant's arguments filed April 26, 2004 have been fully considered but they are not persuasive.

In the remarks, the applicant argues in substance that in Rabne fails to suggest or teach the claimed limitation of transmitting the information from a source to a server wherein the information is in a format viewable by the client.

In response, Rabne discloses that the content is transmitted from a external service provider to the RM system for providing to the client (see fig. 1b; col. 19-20).

The applicant also argues that in Rabne the client requests content from a catalog and not from a web server.

In response, there is no such language of requesting content from a web server in the claims.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The central official fax number for the group is (703) 872-9306.

Saleh Najjar
Primary Examiner / Art Unit 2157